



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/676,946

09/30/2003

Kristin L. Jambor

END5083-515149

7866

26874 7590 07/29/2008

FROST BROWN TODD, LLC
2200 PNC CENTER
201 E. FIFTH STREET
CINCINNATI, OH 45202

EXAMINER

COMSTOCK, DAVID C

ART UNIT

PAPER NUMBER

3733

NOTIFICATION DATE

DELIVERY MODE

07/29/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@fbtlaw.com

Office Action Summary	Application No. 10/676,946	Applicant(s) JAMBOR ET AL.	
	Examiner DAVID COMSTOCK	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

The Oath/Declaration filed 17 October 2007 is accepted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,157,713 to Clarey.

Clarey discloses a band comprising a tension carrying belt (10) and a balloon (24) attached to the tension carrying belt. The balloon comprises a plurality of partitions (22) defining a plurality of inner chambers (26). A fluid supply tube (50,52) is in fluid communication with the balloon and attached to the tension carrying belt. The fluid supply tube further comprises a plurality of inlets wherein each of the plurality of inlets is in fluid communication with a corresponding one of the plurality of inner chambers of the balloon and the fluid supply tube inlets at each end of the partition. A plurality of check valves is located within the plurality of inlets (Column 3, lines 30-42). The valves are considered to be check valves since they prevent backflow of air out of the device and allow movement of air in and out when it is required. The tension carrying belt further comprises a latching mechanism (34, 36). The compartments (26) may also be interpreted as a plurality of balloons. In addition the partitions (22), may also be

interpreted as reinforcing structure. Regarding the preamble "gastric", it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Clarey discloses the claimed invention except for explicitly disclosing the limitations pertaining to the size of the inlets.

However, it would have been obvious to have formed the inlets of an appropriate size, e.g. to accommodate the varying conditions and needs of patients, since it has been held to be within the level of ordinary skill in the art to determine size. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claims 1 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over PG-PUB 2005/0192531 to Birk.

Birk discloses a gastric band comprising a tension carrying belt(10) and a balloon attached to the tension carrying belt (6). The balloon comprises a plurality of partitions defining a plurality of inner chambers (FIG. 4). A fluid supply tube is in fluid communication with the balloon and is attached to the tension carrying belt (paragraph 0030). A latching mechanism comprises one or more sutures (paragraph 0006). The device has a length between 8 and 15 cm (paragraph 0008). The portioned balloon can also be considered a plurality of balloons. The plurality of balloons is attached to the tension carrying belt (FIG. 4). The fluid supply tube comprises a plurality of inlets (paragraph 0006) that are attached to the tension carrying belt such that they provide fluid communication between each of the plurality of balloons and the fluid supply tube (paragraph 0006). The balloons have an interior surface and further comprise one or

more reinforced sections (7) disposed along the length of the interior surface of the balloon (paragraph 0033). Birk discloses the claimed invention except for explicitly disclosing the limitations pertaining to the size of the inlets. However, it would have been obvious to have formed the inlets of an appropriate size, e.g. to accommodate the varying conditions and needs of patients, since it has been held to be within the level of ordinary skill in the art to determine size. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Response to Arguments

Applicant's arguments filed on 05 March 2008, pertaining to the claims as amended on 17 October 2007, have been fully considered but they are not persuasive.

The amendments made to independent claim 1 do not define over the prior art of record. For example, as Applicant notes in the remarks at page 5, lines 15-17, one skilled in the art would naturally expect a balloon to have an exterior surface. As such, it is unclear why such a limitation is being presented in an effort to define over the cited references, which, of course, show such a feature. Not only do the balloons have an exterior surface, but they also comprise portions and partition walls. The plurality of partition walls define a plurality of inner chambers, which are immediately adjacent to one another. The exterior surface is at least adjacent to and against the belt, as by spacing, along at least a length of a balloon wall. Trocars are simply hollow cylinders and the size is not defined. Moreover, the trocar is not positively recited. As such, the devices of the applied prior art are deemed to be of a size that would at least be capable of fitting through a hollow cylinder and around a portion of a patient's stomach.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 3733

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/
Examiner, Art Unit 3733

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733